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REMARKS

Reconsideration of the application and entry of the amendment are respectfully requested. Claims 13 to 23 and 25 to 32 are currently pending, claims 13 to 20 have been withdrawn, and no claims have been amended.

The Office Action mailed September 24, 2004 addressed claims 13 to 23 and 25 to 32. Claims 21 to 23 and 25 to 32 were rejected, and claims 13 to 20 were withdrawn from consideration.

In the Office Action, the Examiner stated that Restriction was required under 35 U.S.C. 121. The Examiner stated that the claims are directed to two distinct inventions as follows: Group I) claims 13 to 20, drawn to a treatment of adhesion; and Group II) claims 21 to 32, drawn to a game ball having enhanced adhesion.

In a telephone call with the Examiner, Group II, claims 21 to 32, was elected. Applicants affirm the election of Group II, claims 21 to 32 without traverse.

Claims 21 to 23, 26, 28 and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sullivan et al. (6,159,110). The Examiner stated that regarding claim 21, Sullivan et al. discloses a game ball having enhanced interlayer adhesion comprising a first layer having a bonding surface, the bonding surface having an adhesion improvement treatment comprising treating the bonding surface with a silicone-based adhesion promoter and a second layer having a surface joined to the bonding surface, wherein the silicone-based adhesion promoter is a silsesquioxane oligomer. The Examiner further stated that regarding claim 22, Sullivan et al. discloses the game ball being a golf ball; regarding claim 23, Sullivan et al. discloses one of the first or second layers is a golf ball mantle comprised of a material selected from at least one of polyurethane, ionomer, terpolymer, metallocene catalyzed polyolefin, polyamide block copolymer and polyester/polyether block copolymer and the other of the first or second layers is a golf ball cover comprised of a material selected from at least one of polyurethane, ionomer, terpolymer, metallocene catalyzed polyolefin, polyamide block copolymer and polyester/polyether block copolymer; regarding claim 26, Sullivan et al. discloses the treatment further comprises post treatment of the game ball at an elevated temperature for a predetermined period of

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time; regarding claim 28, Sullivan et al. discloses a process for improving adhesion strength between a first and second layer comprising treating the first layer with a silicone-based adhesion promoter and joining the second surface to the first surface; and regarding claim 30, Sullivan et al. discloses the silicone based adhesion promoter is a silsesquioxane oligomer.

Applicants respectfully disagree with the Examiner. Sullivan et al. discloses a golf ball having at least one interior layer and/or core composition comprising a silicone material (Abstract, claims). Contrary to the Examiner's assertions, Sullivan et al. does not disclose or claim a golf ball having enhanced interlayer adhesion and a silicone-based adhesion promoter, or more specifically, a silsesquioxane oligomer adhesion promoter. Applicants respectfully submit that the Examiner has mischaracterized the teachings of Sullivan et al. The Examiner points to Column 2, lines 40 to 47 and Column 28, lines 24 to 30 for support. Applicants respectfully submit that Column 2, lines 40 to 47 only discloses one or more silicone interior layers and/or a silicone core, and Column 28, lines 24 to 30 discloses silicone resins that are highly cross-linked siloxanes. Neither of the passages discloses a silicone-based adhesion promoter of any kind. Since Sullivan et al. does not teach each and every element of Applicants' claims 21 and 28, Applicants respectfully submit that Sullivan et al. does not anticipate Applicants' claims. Claims 22, 23, 26, 28 and 30 depend from claims 21 and 28 and are therefore also not anticipated by Sullivan et al. Applicants respectfully request that the Examiner reconsider and withdraw the rejections of claims 21 to 23, 26, 28 and 30 as anticipated by Sullivan et al. under 35 U.S.C. § 102(b).

Claims 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (6,159,110). The Examiner stated regarding claims 25 and 31, Applicant does not state why a particular silsesquioxane oligomer is critical to attain the invention. The Examiner concluded that one skilled in the art would have found such to be an obvious matter of design choice and any type of silsesquioxane or silicon based composition as disclosed by Sullivan would perform equally as well because it promotes adhesion.

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Applicants respectfully disagree with the Examiner and submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Sullivan et al. does not disclose an adhesion promoter, or more specifically, a silsesquioxane oligomer as disclosed in Applicants' invention. Even if Sullivan et al. did disclose silicone adhesion promoters generally, the choice of a particular silsesquioxane oligomer is not "an obvious matter of design choice" and that not all materials "would perform equally as well", as asserted by the Examiner. One skilled in the art would not be motivated by Sullivan et al. to use the claimed material. Applicants respectfully submit that the Examiner has no basis for the broad assertion that any silicone based adhesion promoter would perform the same as any other material. Additionally, the Examiner has clearly failed to consider Applicants' examples where it is clearly shown that all silicone based adhesion promoters do not "perform equally as well", but instead, as shown in Table 3, they perform very differently. Finally, claims 25 and 31 depend from claims 21 and 28, which Applicants respectfully submit are allowable, as discussed above. Therefore, Applicants also respectfully submit that claims 25 and 31 are also allowable.

For at least these reasons, Applicant respectfully submits that claims 25 and 31 are not obvious under 35 U.S.C. 103(a) over Sullivan et al. Applicant therefore respectfully requests that the rejection of 25 and 31 under 35 U.S.C. § 103(a) as obvious over Sullivan et al. be reconsidered and withdrawn.

Claims 27, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (6,159,110) in view of Maruko (6,071,201) and Kitaoh et al. (4,871,589). The Examiner stated regarding claims 27, 29 and 32, Sullivan et al. does not disclose roughening a bonding surface or plasma treating a bonding surface, but Maruko discloses a golf ball having a layer roughened in order to increase the adhesion between two layers, and Kitaoh et al. discloses a golf ball wherein a layer is plasma treated. The Examiner concluded that one of ordinary skill in the art would have found it obvious to roughen a surface, as taught by Maruko, or to plasma treat a surface, as taught by Kitaho et al., in order to further promote adhesion.

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Applicants respectfully disagree with the Examiner and submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Sullivan et al. does not disclose an adhesion promoter, or more specifically, a silsequioxane oligomer as disclosed in Applicants' invention. The addition of secondary references, such as Maruko and Kitaoh et al., does not cure the deficiency in Sullivan et al. The combination of Sullivan et al. and Maruko and/or Kitaoh et al. still does not disclose Applicants' invention. Finally, claims 25 and 31 depend from claims 21 and 28, which Applicants respectfully submit are allowable, as discussed above. Therefore, Applicants also respectfully submit that claims 25 and 31 are also allowable.

For at least these reasons, Applicant respectfully submits that claims 27, 29 and 32 are not obvious under 35 U.S.C. 103(a) over Sullivan et al. in view of Maruko and Kitaoh et al. Applicant therefore respectfully requests that the rejection of 27, 29 and 32 under 35 U.S.C. § 103(a) as obvious over Sullivan et al. in view of Maruko and Kitaoh et al. be reconsidered and withdrawn.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 21 to 23 and 25 to 32. Applicant respectfully requests allowance of claims 21 to 23 and 25 to 32, the claims currently pending.

Respectfully submitted,

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